

## REMARKS

- Claims 1 and 36-46 were pending in the present application
- Claims 1 and 36-46 stand rejected

Upon entry of this amendment, which is respectfully requested for the reasons set forth below:

- Claims 38-39, 43-44, and 47-59 will be pending
- Claims 47-59 will be added
- Claims 1, 36-37, 40-42, and 45-46 will be cancelled without prejudice
- Claims 38, 43-44, 47-48, and 51-59 will be the only independent claims

### Telephone Interview

Applicants would like to thank the Examiner for the helpful telephone conversation held on April 24, 2002 with Applicants' representatives. The Examiner and Applicants' representatives discussed the present application in light of the cited references.

Applicants' representatives suggested that neither the Gerfin reference nor the Hung reference, alone or in combination, teaches or suggests all of the features of any of independent Claims 38, 40, and 43-46. The Examiner did not agree.

The Examiner indicated that the Section 112, paragraph 2 rejection of independent Claims 41-46 would be withdrawn.

Applicants are grateful for the opportunity to discuss the present application with the Examiner.

### Request for Continued Examination

Applicants have filed a Request for Continued Examination concurrently with this Response and Amendment.

### Claim Amendments

Claims 1, 36-37, 40-42, and 45-46 have been cancelled without prejudice

Claims 1, 36-37, 40-42, and 45-46 have been cancelled without prejudice in order to expedite prosecution of the present application. At this time, Applicants plan to pursue the subject matter of Claims of 1, 36-37, 40-42, and 45-46 in a continuing application.

### Section 112, Paragraph 1 Rejection of Claims 1 and 36-37

Claims 1 and 36-37 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed

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invention. Applicants respectfully traverse the Examiner's 112 rejection of Claims **1 and 36-37** and the Examiner's assertion that the feature of "in response to expiration of a period of time that is measured from a time of player selection of the subject game element having the first class..." is "new matter."

However, Claims **1 and 36-37** have been cancelled without prejudice in order to expedite prosecution of the present application. Accordingly, the Section 112, paragraph 1 rejection is moot.

### **Section 112, Paragraph 2 Rejection of Claims 41-46**

Independent Claims **41-46** stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicants respectfully traverse the rejection.

Independent Claims **41-42 and 45-46** have been cancelled. Applicants respectfully traverse the rejection of Claims **41-42 and 45-46** for the reasons stated below with respect to Claims **43-44**.

Applicants have drafted claims which refer to more than a single statutory class. There are many situations where claims are permissively drafted to include a reference to more than one statutory class of invention. MPEP 2173.05(p)(I). For example, a product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. MPEP 2173.05(p)(I). Similarly, a claim to a product may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process. MPEP 2173.05(p)(I).

Claim **43** is an apparatus claim that includes a reference to a method claim. In particular, Claim **43** is directed to an apparatus that may perform the method of Claim **38**. To make the claim easier to examine, read, and compare with one another, Claim **43** has been written in simplified form so that it refers to Claim **38**, by number, rather than directly reciting all of the steps of method claim. It is clear that Claim **43** is directed to the apparatus operable of performing the method, and not to the method itself. Similarly, Claim **44** is an article of manufacture claim that includes a reference to the method of Claim **38**.

Furthermore, Claims **43-44** are independent, not dependent on Claim **38**, and accordingly Applicants have paid the higher fee for independent Claims **43-44**. A claim is dependent if it cannot conceivably be infringed by anything which would not also infringe the independent claim. MPEP 608.038(n)(III). In other words, if a claim is infringed by something that does not infringe the independent claim, then that claim is not dependent on the independent claim -- it is also an independent claim.

Claims **43-46** are independent. For example, Claim **43** is not dependent on independent Claim **38**, because one could infringe Claim **43** without infringing Claim **38**. Note that the apparatus of Claim **43** is capable of performing the method of Claim **38**, but need not actually perform the method. For example, one could infringe Claim **43** by making or selling the claimed apparatus without ever activating the apparatus. Since the apparatus is not activated, it does not perform the method claimed in Claim **38**, and thus claim **38** cannot be infringed even while Claim **43** is infringed.

Accordingly, Applicants respectfully submit that independent Claims **41-46** satisfy the requirements of Section 112, second paragraph.

### Section 102(b) Rejection

Claims **40 and 45-46** stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,735,982 issued to Gerfin ("Gerfin"). Applicants respectfully traverse the Examiner's Section 102(b) rejection.

Applicants respectfully submit that Gerfin does not teach or suggest all of the features of any of Claims **40 and 45-46**. Specifically, Applicants respectfully traverse the Examiner's assertion that Gerfin teaches: "After each flip-flop cycle the cards expire and another card is shown." In fact, there is no suggestion in Gerfin that a subject game element "expires" at the end of a flip-flop cycle or at any other time.

However, Claims **40 and 45-46** have been cancelled without prejudice. Accordingly, the Section 102(b) rejection is moot.

### Section 103(a) Rejection

Claims **38-39 and 43-44** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gerfin, and further in view of U.S. Patent No. 3,961,473 issued to Hung, et al. ("Hung"). Applicants respectfully traverse the Examiner's Section 103(a) rejection.

The Examiner asserts that it would have been obvious "to include a countdown timer display in the invention of Gerfin" because "a player would like to know how much time they have left to activate the push-button switches to lock the card into place." Applicants respectfully traverse this assertion.

As discussed with the Examiner, Gerfin describes a clock frequency of at least 4-10 pulses per second ("pps"). Column 3, line 63 to column 4, line 1; Column 4, lines 14-20. Applicants respectfully submit that in light of how little time is described in Gerfin to select an illuminated card before it is replaced, e.g., 0.25 to 0.10 seconds or less, it would not have been obvious, useful, or practical to modify Gerfin to provide for a "countdown timer display." Even if a player would like to know how much time is left before the next card transparency is illuminated, an assertion that Applicants' traverse, a user of the Gerfin device may not even be able to read a displayed countdown that expired so quickly, much less find the display useful, particularly if the player also needs to "distinguish the various card faces appearing on the respective screens" during that brief time. Column 3, line 67 to Column 4, line 1.

Accordingly, it would not have been obvious to modify Gerfin to provide for a feature of *displaying an indicia representing forthcoming expiration of the first class corresponding to the subject game element*, as recited in independent Claim 38. Neither the references nor the knowledge generally available to one of ordinary skill in the art at the time of invention, alone or in combination, suggest the modification of Gerfin suggested by the Examiner.

Accordingly, with respect to Claims **38-39** and independent Claims **43-44**, which recite features generally directed to performing the method of Claim 38, Applicants respectfully submit that it would not have been obvious to modify Gerfin in light of Hung. Applicants respectfully submit that Claims **38-39 and 43-44** contain allowable subject matter.

### Newly-Added Claims 47-59 Are Patentable Over the Cited References

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Newly-added Claims 47-59 are patentable over Gerfin, Hung, and Hamano for at least the reasons presented herein.

According to various embodiments of the present invention, a card having an assigned rank and suit combination is dealt and displayed to a player. See, e.g., Specification, page 11, lines 17-18; FIG. 5A. After the card is dealt, a player may identify a location at which the dealt card is to be placed (e.g., a game set, a poker hand). The card is then displayed at the identified location. See, e.g., Specification, page 11, lines 18-22; FIG. 5B. A player may request another card be dealt and displayed. See, e.g., Specification, page 11, lines 22-23.

According to other various embodiments, the attributes of a displayed game element (e.g., ace of hearts) may be changed. For example, a replacement rank and suit combination (e.g., nine of hearts) is determined, and a representation of the replacement rank and suit combination is displayed at the location of the displayed card. See, e.g., Specification, page 20, lines 13-16; page 12, line 22 to page 13, line 4; FIGS. 5D-5E.

None of the cited references, alone or in combination, suggests (i) a game element expiring or changing after a period of time and (ii) the game element being displayed at a first location and a second location. Specifically, there is no suggestion in the cited references to change or expire a game element after a period of time and locate the game element in a game set (e.g., a poker hand). Applicants respectfully submit that the cited references, alone or in combination, do not teach or suggest features generally directed to (i) *displaying the subject game element at a first location, thereby displaying an indicia of the first class*, (ii) *receiving from a player a placement signal that indicates a second location*, and (iii) either:

- *in response to expiration of a period of time, assigning a second class to the subject game element*
- *displaying the subject game element at the second location, thereby displaying an indicia of the second class*

as recited in new independent Claim 57;

- *displaying the subject game element at the second location, thereby displaying the indicia of the first class*
- *in response to expiration of a period of time, assigning a second class to the subject game element*
- *displaying the subject game element at the second location, thereby displaying an indicia of the second class*

as recited in new independent Claim 58; or

- *displaying the subject game element at the second location*
- *in response to expiration of a period of time, erasing the subject game element*

as recited in new independent Claim 59.

None of the cited references, alone or in combination, suggests (i) a first game element being displayed at a location, (ii) the first game element expiring or changing after a period of

time, and (iii) a second game element being displayed at the same location before the first game element expires or changes. Applicants respectfully submit that the cited references, alone or in combination, do not teach or suggest features generally directed to (i) *displaying the subject game element at a location, thereby displaying an indicia of the first class*, and (ii) either:

- *in response to expiration of a period of time, assigning a second class to the first subject game element*
- *displaying the first subject game element, thereby displaying an indicia of the second class*
- *generating a second subject game element having a third class*
- *displaying the second subject game element at the location before the expiration of the period of time, thereby displaying an indicia of the third class*

as recited in new independent Claims 47-48; or

- *determining expiration of a period of time*
- *receiving a placement signal from a player, the placement signal indicating a second location*
- *before the expiration of the period of time, displaying the first representation at the second location*
- *before the expiration of the period of time, displaying a second representation of a card at the first location, the second representation including an indicia of a second class*
- *in response to the expiration of the period of time, assigning a third class to the first representation*
- *displaying the first representation, the first representation including an indicia of the third class*

as recited in new independent Claim 51.

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None of the cited references, alone or in combination, suggests (i) a game element being displayed at a first location and a second location, and (iii) preventing the game element from expiring or changing. Specifically, there is no suggestion in the cited references to prevent the changing or expiring of a displayed game element after a period of time and locating the game element in a game set (e.g., a poker hand) after it is dealt. Applicants respectfully submit that the cited references, alone or in combination, do not teach or suggest features generally directed to (i) *displaying the subject game element at a first location, thereby displaying an indicia of the first class*, and (ii) *receiving from a player a placement signal that indicates a second location*, (iii) *displaying the subject game element at the second location*, and (iv) either:

- *receiving a signal via a lock button, the signal effective to prevent the subject game element from expiring*

as recited in new independent Claim 52;

- *receiving a signal via a lock button, the signal effective to prevent the first class from expiring*

as recited in new independent Claim 53; or

- *receiving a signal via a lock button, the signal effective to prevent the subject game element from changing*

as recited in new independent Claim 54.

As discussed above with respect to independent Claim 38, there is no hint or suggestion in the cited references to provide for displaying an indicia representing forthcoming expiration of either (i) a game element or (ii) a class of a subject game element. Accordingly, Applicants respectfully submit that new independent Claims 55-56 contain allowable subject matter.

For the reasons stated herein, Applicants respectfully submit that new Claims 47-59 are allowable.

### Conclusion

It is submitted that all of the claims are now in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mtdowns@walkerdigital.com](mailto:mtdowns@walkerdigital.com).

### Petition for Extension of Time to Respond

Applicants hereby petition for a one-month extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



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Date

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